



PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of

Hirofusa SHIRAI et al.

Group Art Unit: 1612

Application No.: 10/579,059

Examiner: M. SZNAIDMAN

Filed: May 11, 2006

Docket No.: 127928

For: ALLERGEN DECOMPOSER AND ANTIALLERGENIC FEATHERS

RESPONSE TO RESTRICTION AND ELECTION OF SPECIES REQUIREMENTS

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In reply to the November 5, 2008 Restriction and Election of Species Requirements, the shortened statutory period for reply having been extended by the attached Petition for Extension of Time, Applicants provisionally elect Group IV, claims 23-29, and elect metal phthalocyanine tetracarboxylic acid as a Species, with traverse.

Applicants respectfully submit that the election of metal phthalocyanine tetracarboxylic acid defines the R^1_{n1} , R^2_{n2} , R^3_{n3} and R^4_{n4} substituents of formula (II) as required by the Office Action. See Office Action at pages 3-4; specification at pages 5-6 (formula (IV)). It is unclear to Applicants whether the Office Action is also requiring Applicants to elect a specific metal for metal phthalocyanine tetracarboxylic acid. If Applicants are required to elect a specific metal for metal phthalocyanine tetracarboxylic acid, Applicants elect iron (i.e. iron phthalocyanine tetracarboxylic acid).

At least claims 1-12, 14-16, 18-20 and 22-29 read on the elected species. At least claims 1, 4, 6, 9, 11, 15 and 19 are generic.

National stage applications filed under 35 U.S.C. §371 are subject to unity of invention practice as set forth in PCT Rule 13, and are not subject to U.S. restriction practice. *See* MPEP §1893.03(d). PCT Rule 13.1 provides that an "international application shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept." PCT Rule 13.2 states:

Where a group of inventions is claimed in one and the same international application, the requirement of unity of invention referred to in Rule 13.1 shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features. The expression "special technical features" shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art.

A lack of unity of invention may be apparent "*a priori*," that is, before considering the claims in relation to any prior art, or may only become apparent "*a posteriori*," that is, after taking the prior art into consideration. *See* MPEP §1850(II), quoting *International Search and Preliminary Examination Guidelines* ("ISPE") 10.03. Lack of *a priori* unity of invention only exists if there is no subject matter common to all claims. *Id.* If *a priori* unity of invention exists between the claims, or, in other words, if there is subject matter common to all the claims, a lack of unity of invention may only be established *a posteriori* by showing that the common subject matter does not define a contribution over the prior art. *Id.* Furthermore, unity of invention only needs to be determined in the first place between independent claims, and not the dependent claims. *See* ISPE 10.06.

The Office Action acknowledges that *a priori* unity of invention exists because all of the claims have a metal phthalocyanine derivative as a common technical feature. *See* page 2. The common technical feature of the claims goes well beyond the metal phthalocyanine derivative alone. In addition, the special technical feature includes an "allergen decomposer"

common to independent claims 1, 6, 11, 15, 19 and 23 in which "[the] allergen decomposer comprises the metal phthalocyanine derivative" recited by the same (emphasis added).

Applicants respectfully submit that a lack of unity of invention may only be determined *a posteriori* by establishing that the claimed allergen decomposer is known in the prior art. *See* ISPE 10.07 and 10.08. JP A-61-258806, relied upon by the Office Action, does not teach or suggest an allergen decomposer comprising a metal phthalocyanine derivative. Rather, in the Abstract, JP A-61-258806 only discloses a polymeric material with semi-permanent deodorant function. The polymeric material carries metallic phthalocyanine.

Because JP A-61-258806 fails to teach or suggest an allergen decomposer comprising a metal phthalocyanine derivative as recited by the claims, Applicants respectfully submit that the Office Action has failed to establish a *prima facie* lack of unity of invention. Thus, the restriction requirement is improper, and its withdrawal is respectfully requested.

Moreover, a restriction between different embodiments (species) of an invention encompassed by an independent claim is only proper under PCT Rule 13 if the claim recites distinct embodiments (such as a Markush group), and the Office Action establishes that the distinct embodiments share no common subject matter that defines a contribution over the prior art. *See* IPSE 10.09; MPEP §1850(II). Neither of these conditions have been met in this case. Accordingly, the election of species requirement is improper and must be withdrawn.

Alternatively, it is understood, that upon search, examination, and allowance of the elected species, search and examination will continue as to the non-elected species within the scope of the generic claims. Because the generic claims are believed to be allowable, Applicants respectfully request rejoinder and examination of the non-elected species.

Reconsideration and withdrawal of the restriction and election of species requirement
are respectfully requested.

Respectfully submitted,



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WPB:MCB/amw

Attachment:
Petition for Extension of Time

Date: January 5, 2009

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